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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,407	11/12/2003	George H. Forman	200300822-1	6790

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FORT COLLINS, CO 80527-2400

EXAMINER
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LY, CHEYNE D

ART UNIT	PAPER NUMBER
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2168

NOTIFICATION DATE	DELIVERY MODE
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03/20/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/706,407	<b>Applicant(s)</b> FORMAN ET AL.	
	<b>Examiner</b> CHEYNE D. LY	<b>Art Unit</b> 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8-17,37-45 and 47-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 8-17, 37-45, and 47-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicants' arguments filed December 14, 2007 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.
2. Claims 1, 3-5, 8-17, 37-45, and 47-50 are examined on the merits.

### **RESPONSE TO ARGUMENTS**

3. On page 3, Applicant argues Anderson does not disclose "using an auxiliary criterion to identify a group of email addresses by querying at least one database to identify individuals who satisfy the auxiliary criterion." Applicant's argument is not persuasive because Anderson describes the argued limitations (page 29, last paragraph, especially, "allows user to request class rolls...", to page 31, pages 32-33, especially, "Class Distribution List" and "Departmental Distribution List" the SELECT statements). For example, Anderson discloses the creating a class distribution list from Csci1101001 (page 32, Class Distribution List section) wherein the disclosure of Csci1101001 has been interpreted as an auxiliary criterion. Anderson permits the user "to name the distribution lists so that the user can find them in their e-mail client" (page 27, line 9). Anderson describes the auxiliary criterion has been used as an "alias Csci1101001" (naming) (page 19, line 6) for a distribution list for a Csci1101001 class. It is well known in the art that aliases for distribution list are entered into an address field of an email application to refer to the list of email address in the list.

4. On pages 3-4, Applicant argues the distribution list of Anderson is stored in static list of email...nothing in Anderson to alert the user that any such changes has taken place..."  
Applicant argument is not persuasive because the argued limitations are not recited in the claims.
5. As for the argued limitation of information pertaining to the auxiliary criterion can be entered into an address field for the email message and then the appropriate recipients are searched based on that auxiliary criterion before the email message is sent. It is noted that no where does claim 1 recite the argued limitation. Further, claim 1, last line, recites "the signal is included within an address field for the email message" wherein "the signal" does not refer to the auxiliary criterion as alleged by Applicant.
6. Anderson describes the auxiliary criterion has been used as an "alias Csci1101001" (page 19, line 6) for a distribution list for a Csci1101001 class. It is well known in the art that aliases for distribution list are entered into an address field of an email application to refer to the list of email address in the list. Therefore, Anderson reasonably anticipate the limitation of "the signal is included within an address field for the email message."
7. On pages 4-8, Applicant argues by asserting that Anderson describes the creation of an "entire database...and stored locally before any distribution list can be created...."  
Applicant's argument is not persuasive because the argued claims 1 and 42 merely recite "querying at least one database..." Therefore, the required limitation "at least one database" does not require the database to be local or external as asserted by Applicant.  
As for the argued limitation "an external database", the List Maker has implemented with data access objects technology to permit "access and manipulate data in local or **remote**

**databases** and to manage databases, their objects, and their structure" (page 36, last paragraph).

### **CLAIM REJECTIONS - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-5, 8-11, 13, 37-45, and 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson, A. (May 2001) (Anderson hereafter).

10. In regard to claim 1, Anderson discloses a processor-based method for addressing an email message (page 10, 4<sup>th</sup> paragraph, especially, “automated mailing list generation. The software described here creates e-mail distribution list”) the processor-based method comprising:

Defining at least one auxiliary criterion by accepting a signal from a user input device (page 26, Typical User section) to at least partially define the at least one auxiliary criterion, wherein the auxiliary criterion uses information other than information in an email address (page 29, last paragraph, especially, “allows user to request class rolls...”, to page 31, pages 32-33, especially, “Class Distribution List” and “Departmental Distribution List” especially, “the user can generate a distribution list by selection colleges, classifications, and majors from a drop down list box”);

Using the auxiliary criterion to identify a group of email addresses by querying at least one database to identify individuals who satisfy the auxiliary criterion (page 29, last paragraph,

especially, “allows user to request class rolls...”, to page 31, pages 32-33, especially, “Class Distribution List” and “Departmental Distribution List” the SELECT statements); and

Sending the email message to the email addresses within the identified group (page 2, 2<sup>nd</sup> paragraph, “send messages to multiple recipients) wherein the signal is included within an address field for the email message (pages 32-33, especially, “Class Distribution List” and “Departmental Distribution List” especially, “the user can generate a distribution list by selection colleges, classifications, and majors from a drop down list box”, and page 38, especially, “Using the Distribution Lists” section).

11. In regard to claims 3-5 and 13, Anderson describes the claimed invention as cited above. Further, Anderson in the cited portion above describes “SELECT NAME, EMAIL...” which represent the email address is part of the search/addressing request.

12. In regard to claims 8-11, Anderson describes the group of email address is identified by a local processor to communicating with an external database remote from the local processor, wherein the auxiliary criterion is used by the local processor to access information in the external database (page 11, lines 10, e.g. SIS database, page 29, “Requesting Class Rolls” section, to page 30, “Receiving the Information section”).

13. In regard to claims 37 and 38, Anderson describes the signal from the user input device comprises a text string including a relational expression that defines the group (pages 32-33, especially, “Class Distribution List” and “Departmental Distribution List” and “SELECT NAME, EMAIL...”).

14. In regard to claims 39 and 40, Anderson describes the external database includes a human resource database and a facilities database (page 32 in its entirety). It is noted that page

describes students database and departmental database which have been interpreted as the claimed database, as supported by the definitions of “human resource” and “facilities” by dictionary.com provide with the instant Office Action.

15. In regard to claim 41, Anderson describes the defining, using and sending steps are performed by an email client (page 38, “Using the Distribution Lists” section, especially, “e-mail client”).

16. In regard to claims 42-45, Anderson describes the computer readable medium (page 10, 4<sup>th</sup> paragraph, especially, “automated mailing list generation. The software described here creates e-mail distribution list”) for the above cited method.

17. In regard to claims 47 and 49, Anderson describes the defining step is performed by an email client, and wherein the auxiliary criterion specifies at least one of: geographical location information, employment information, manager information, project information, meeting attendance information, department information, company division information and organizational information pertaining to an intended email recipient (pages 32-33, especially, “Class Distribution List” and “Departmental Distribution List” and especially, “the user can generate a distribution list by selection colleges, classifications, and majors from a drop down list box”, and page 38, especially, “Using the Distribution Lists” section).

18. In regard to claims 48 and 50, Anderson describes the group of email addresses is identified by the email client communicating with a database that is external to an email system of which the email client is a part (page 11, lines 10, e.g. SIS database, page 29, “Requesting Class Rolls” section, to page 30, “Receiving the Information section”).

19. In regard to claims 49 and 50,

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

22. Claims 12 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, A. (May 2001) (Anderson hereafter) as applied to claims 1, 3-5, 8-11, 13, and 37-45 above, and further in view of Microsoft Press (1999).

**MOTIVATION**

23. Anderson describes an improvement to the Microsoft Outlook client to automate mailing list generation (page 10, 4<sup>th</sup> paragraph). Microsoft describes the well known in the art Outlook client for creating distribution lists (page 51, in its entirety). One of ordinary skill in the art at the time of the invention would have been motivated by Anderson to improve Outlook to automate mailing list generation.



## **PRIOR ART**

24. In regard to claims 12 and 14-17, Anderson does not specify that the information being an identification of a manager's name, a company division, a project, an identification of a meeting, or a geographic location. Microsoft Press describes it is well known in the art that Outlook has been used to create distribution lists for any auxiliary criterion simply by naming the distribution list (page 51, in its entirety). Therefore, it would have been obvious to one of ordinary skill in the art to improve Outlook to include a variety of information such as an identification of a project, an identification of a meeting, or a geographic location to automate mailing list generation.

## **CONCLUSION**

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2168

27. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

28. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571)272-3642.

/Cheyne D Ly/

Primary Examiner, Art Unit 2168